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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/932,793	08/17/2001	Chew Kai Hwa	1085-029/ddh	5435

21034 7590 09/26/2002

IPSOLON LLP
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EXAMINER

IP, SIKYIN

ART UNIT	PAPER NUMBER
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1742

DATE MAILED: 09/26/2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 12/31/01
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-16 is/are pending in the application.
- ☐ Of the above claim(s) is/are withdrawn from consideration.
- ☐ Claim(s) is/are allowed.
- ☒ Claim(s) 1-16 is/are rejected.
- ☐ Claim(s) is/are objected to.
- ☐ Claim(s) are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

DETAILED ACTION

Specification

1. The layout of the instant disclosure is unclear. The following guidelines illustrate the preferred layout and content for patent applications. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

The following order or arrangement is preferred in framing the specification and, except for the reference to the drawings, each of the lettered items should appear in upper case, without underling or bold type, as section headings. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) Title of the Invention.
 - (b) Cross-Reference to Related Applications.
 - © Statement Regarding Federally Sponsored Research or Development.
 - (d) Reference to a "Sequence Listing," a table, or a computer program listing appendix submitted on compact disc (see 37 CFR 1.52(e)(5)).
 - (e) Background of the Invention.
 1. Field of the Invention.
 2. Description of the Related Art including information disclosed under 37 CFR 1.97 and 1.98.
 - (f) Brief Summary of the Invention.
 - (g) Brief Description of the Several Views of the Drawing(s).
 - (h) Detailed Description of the Invention.
 - (I) Claim or Claims (commencing on a separate sheet).
 - (j) Abstract of the Disclosure (commencing on a separate sheet).
 - (k) Drawings.
 - (l) Sequence Listing, if on paper (see 37 CFR 1.821-1.825).
2. The disclosure is objected to because of the following informalities: In page 5, last paragraph of the instant specification that, the brief description of the drawing

for Figures 10A and 10B are not being complied with the 37 C.F.R. §1.74. It is required that a separate brief description for each figure including sub-figures. See MPEP § 608.01 (f) and 608.02. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claims 1, 6, and 11 are indefinite because the instant specification fails to provide a standard for measuring the degree of closeness or proximity of the wording "substantially" on line 1 of said claims. In *Seattle Box Co. v. Industrial Crating & Packing*, 731 F.2d 818, 826, 221 USPQ 568, 573-574 (Fed. Cir. 1984).

6. Claims 11-16 provide for the use of claimed Pb-free solder, but, since the claims do not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim Rejections - 35 USC § 101

7. Claims 11-16 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 103

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 1-4, 6-9, and 11-16 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over WO 9709455 (abstract, alloys c and f-h).

11. Claims 1-4, 6-9, and 11-15 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over USP 5538686 to Chen et al (col. 1, line 60 to col. 2, line 37), JP 10314980 (abstract), JP 2000141078 (abstract), WO 2000018536 (abstract), or JP 11221694 (abstract).

12. The cited reference(s) disclose(s) the features including the claimed Pb-free Sn based solder. The difference between the reference(s) and the claims are as follows: Cited references' solder alloys do not disclose P element. But, P element content in instant claims 2, 3, 7, 8, and 12 reads on zero which suggests said P element could be eliminated from the claimed solder alloy. Therefore, the subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have selected the overlapping portion of the subject matter disclosed by the reference. Overlapping ranges have been held to be a prima facie case of obviousness, See MPEP § 2112.01, In re Best, 195 USPQ 430, In re Malagari, 182 USPQ 549, In re Titanium Metals Corporation of America v. Banner, 227 USPQ 773 (Fed. Cir. 1985), In re Woodruff, 16 USPQ 2d 1934, and In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976).

13. Claims 5 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over references as applied to claims 1-4, 6-9, and 11-16 above, and further in view of JP 2001058286 (abstract).

14. The claimed subject matter as is disclosed and rejected above by the cited reference(s) except for P element. However, JP 2001058286 in the abstract teaches P content less or equal to 0.2 wt.% could be added as antioxidant element in the same field of endeavor or the analogous metallurgical art. Therefore, it would have been obvious to one having ordinary skill in the art of the cited references at the time the invention was made to provide Sn base solder with P element as taught by JP 2001058286 in order to improve antioxidant. It has been held that combining known ingredient having known functions, to provide a composition having the additive effect of each of the known functions is within realm of performance of ordinary skill artisan. In re Castner, 186 USPQ 213 (217). The use of conventional materials to perform their known functions in a conventional process is obvious. In re Raner, 134 USPQ 343 (CCPA 1962).

Conclusion

All recited limitations in the instant claims have been met by the rejections as set forth above.

Applicant is reminded that when amendment and/or revision is required, applicant should therefore specifically point out the support for any amendments

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made to the disclosure. See MPEP § 2163.06 (a) and 37 C.F.R. § 1.119.


Examiner Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Ip whose telephone number is (703) 308-2542. The examiner can normally be reached on Monday to Friday from 5:30 A.M. to 2:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Roy V. King, can be reached on (703)-308-1146.

The facsimile phone number for this Art Unit 1742 are (703) 305-3601 (Official Paper only) and (703) 305-7719 (Unofficial Paper only). When filing a FAX in Technology Center 1700, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communication with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0651.



SIKYIN IP
PRIMARY EXAMINER
ART UNIT 1742

S. Ip
September 23, 2002